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In re Application of :  
TEITELBAUM *et al* :  
U.S. Application No.: 10/534,055 :  
PCT No.: PCT/US03/09285 :  
Int. Filing Date: 25 March 2003 :  
Priority Date: None :  
Docket No.: 64118.000192 :  
For: TRANSPEDICULAR :  
INTERVERTEBRAL DISK ACCESS :  
METHODS AND DEVICES :

**DECISION ON  
RENEWED PETITION  
UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Renewed Petition under 37 CFR §1.47(a)" filed 06 June 2006.

**BACKGROUND**

On 09 May 2006, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. There was conflicting information regarding whether the nonsigning inventor could be located. Moreover, the declaration provided was not in compliance with 37 CFR 1.497. Applicants were given two months to respond.

On 06 June 2006, applicants submitted via facsimile a renewed petition which was accompanied by, *inter alia*, a declaration of Robert A. King ("Decl."); a copy of a letter dated 18 May 2006 with copies of the postal receipts; and a declaration signed by six of the seven named inventors.

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the nonsigning joint inventor. Petitioners satisfied item (1) with the initial petition and items (3) and (4) with the renewed petition.

Petitioners declare that the last known address of Mr. Frank Nguyen is:

1995 E. Coalton Road  
Superior, CO 80027

Regarding item (4), the 37 CFR 1.47(a) applicant submitted complete declarations signed by six of the seven joint inventors on behalf of the nonsigning inventor. All of the inventor's names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of 37 CFR 1.497(a) and (b) and section 409.03(a) of the MPEP.

However, petitioners have not yet satisfied item (2) of 37 CFR 1.47(a).

Petitioners submitted evidence filed in an earlier U.S. application (No. 10/999,216) showing that a diligent effort was made to locate Mr. Nguyen. This search was conducted by Sabrina Chambers prior to 15 August 2005.<sup>1</sup>

In the renewed petition, the 37 CFR 1.47(a) applicants submitted a declaration of Robert A. King who states that the certified mail postcard signed as received by Mr. Nguyen on 01 November 2005 clearly established that Superior, Colorado, was his last known mailing address. Decl. at ¶ 4. Petitioners mailed a certified letter on 18 May 2006 to this address along with a copy of the application and a declaration requesting that Mr. Nguyen respond. The letter was returned as undeliverable. Petitioners submitted no other evidence on this matter.

First, the showing that a diligent effort was made to locate Mr. Nguyen submitted in U.S. application No. 10/999,216 on 16 August 2005 is no longer relevant as there is credible evidence to suggest that Mr. Nguyen was living in Louisville, Colorado on 01 November 2005. Since the letter sent to the last known address of Mr. Nguyen on 18 May 2006 was returned as undeliverable, it is not clear whether Mr. Nguyen is aware of the subject application. Petitioners must attempt to determine where Mr. Nguyen now resides.

If petitioners conclude that Mr. Nguyen still lives at the Louisville, Colorado address but refuses to accept delivery of mail, **this conduct would constitute a refusal to cooperate.** If petitioners are unable to determine where Mr. Nguyen lives, **a statement of facts should be submitted that fully describes the steps taken to locate the whereabouts of the nonsigning inventor.** Copies of documentary evidence such as internet and telephone searches that support a finding that the nonsigning inventor could not be found or reached should be made part of the

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<sup>1</sup> The declaration of Ms. Chambers filed with the petition in U.S. Application 10/999,216 was dated 15 August 2005.

statement of facts. See MPEP § 409.03(d).

For the reasons noted above, item (2) of 37 CFR 1.47(a) is not yet satisfied.

### CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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